

REMARKS

The Applicants have carefully reviewed the Final Office Action mailed April 4, 2008 (hereinafter “Final Office Action”) and offer the following remarks.

Initially, the Applicants wish to thank Examiner Divecha for taking the time to speak with the Applicants’ representative, Tony Josephson, on May 1, 2008. During the Telephonic Interview, Examiner Divecha kindly pointed out that claims 25-36 have not been rejected under 35 U.S.C. § 101.

Claims 1-7, 9, 13-19, 21, 25-31, 33, and 37-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0062336 A1 to *Teodosiu et al.* (hereinafter “*Teodosiu*”) in view of U.S. Patent No. 6,393,488 B1 to *Araujo* (hereinafter “*Araujo*”). The Applicants respectfully traverse the rejection. More specifically, claim 1 recites a method for optimizing private network file transfers comprising, among other features, “determining by the server that the first and second nodes are part of the same private network,” where the first and second nodes are part of a peer-to-peer network. Claims 13, 25, and 37 include similar features. The Applicants submit that none of the references, either alone or in combination, disclose determining by a server that first and second nodes, which are part of a peer-to-peer network, are also part of a same private network. As correctly pointed out by the Patent Office, *Teodosiu* does not disclose this feature. (See Final Office Action, page 7). Similarly, *Araujo* does not disclose this feature. Nevertheless, the Patent Office maintains the rejection by indicating that *Araujo* discloses this feature in col. 7, ll. 13-65 and in Figure 5, element 511. (See Final Office Action, page 7). The Applicants respectfully disagree. At most, *Araujo* discloses determining if a device resolving a DNS is included in the same LAN as a device initiating a URL request. (See *Araujo*, Figure 5, element 511 and col. 7, ll. 31-33). However, the Applicants submit that *Araujo* does not disclose that the devices in the same LAN are part of a peer-to-peer network.

The Patent Office responds to this line of reasoning by indicating that the feature of determining by a server, that first and second nodes, which are part of a peer-to-peer network, are also part of a same private network, is not recited in the claim. Instead, according to the Patent Office, the feature of first and second nodes, which are part of a peer-to-peer network, are only recited in the preamble and not in the claims. (See Final Office Action, pages 2 and 3). The Applicants respectfully disagree. Regarding claim 1 element (a) recites receiving by the server a

search request from a first node of the plurality of nodes in the peer-to-peer public network for a file, and element (b) recites determining by the server that the file is stored on a second node of the plurality of nodes in the peer-to-peer network. Claim 25 includes similar features. Thus, contrary to what is asserted by the Patent Office, claims 1 and 25 clearly recite that the first and second nodes are part of a peer-to-peer network.

Claim 13 recites “a first plurality of nodes coupled to the peer-to-peer public network.” Claim 13 also recites “a private network including first and second nodes of the first plurality of nodes coupled to the peer-to-peer public network.” As such, claim 13 clearly recites that the first and second nodes are part of a peer-to-peer network.

Claim 37 recites a “method for optimizing private network file transfers in a peer-to-peer public network, the peer-to-peer public network including a server and a plurality of nodes.” According to Chapter 2111.02 of the M.P.E.P., “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” Moreover, according to Chapter 2111.02, “statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim.” As detailed above, the feature of a peer-to-peer public network including a server and a plurality of nodes recited in the preamble results in a structural and manipulative difference between the present claims and the prior art. Accordingly, this feature is a part of claim 37.

In addition, the Patent Office responds to the argument that none of the references disclose determining by a server that first and second nodes, which are part of a peer-to-peer network, are also part of a same private network by indicating that the Applicants are attempting to show non-obviousness by arguing the references individually. (See Final Office Action, page 3). The Applicants respectfully disagree. Particularly, the Patent Office has acknowledged that *Teodosiu* does not disclose that a server determines that first and second nodes are part of the same private network. (See Office Action mailed November 1, 2007, page 7; and Final Office Action, page 7). Thus, the Patent Office has implicitly acknowledged that *Teodosiu* does not disclose that a server determines that first and second nodes are part of the same private network,

where the first and second nodes, which are part of the same private network, are also part of a peer-to-peer network. In light of the acknowledged shortcoming in *Teodosiu*, the Patent Office turns to *Araujo*. The Applicants are merely rebutting the argument proffered by the Patent Office explaining why, just like *Teodosiu*, *Araujo* does not disclose determining by a server that first and second nodes, which are part of a peer-to-peer network, are also part of a same private network. Thus, the Applicants, are arguing why, in combination, neither *Teodosiu* nor *Araujo* discloses all of the features recited in claims 1-7, 9, 13-19, 21, 25-31, 33, and 37-40.

Accordingly, claims 1, 13, 25, and 37 are patentable over the cited references and the Applicants request that the rejection be withdrawn. Likewise, claims 2-7, 9, 14-19, 21, 26-31, 33, and 38-40, which variously depend from claims 1, 13, 25, or 37, are patentable for at least the same reasons along with the novel features recited therein.

Claims 8, 10, 12, 20, 22, 24, 32, 34, 36, 41, and 43-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Teodosiu* in view of *Araujo* and further in view of U.S. Patent No. 6,636,854 B2 to *Dutta et al.* (hereinafter “*Dutta*”). The Applicants respectfully traverse the rejection. As detailed above, claims 1, 13, 25, and 37, the base claims from which claims 8, 10, 12, 20, 22, 24, 32, 34, 36, 41, and 43-47 variously depend, are patentable over *Teodosiu* and *Araujo*. In addition, *Dutta* does not overcome the previously noted shortcomings of *Teodosiu* and *Araujo*. As such, claims 8, 10, 12, 20, 22, 24, 32, 34, 36, 41, and 43-47 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claims 11, 23, 35, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Teodosiu* in view of *Araujo* and *Dutta* and further in view of U.S. Patent No. 6,553,310 B1 to *Lopke* (hereinafter “*Lopke*”). The Applicants respectfully traverse the rejection. As mentioned above, claims 1, 13, 25, and 37, the base claims from which claims 11, 23, 35, and 42 respectively depend, are patentable over *Teodosiu*, *Araujo*, and *Dutta*. Moreover, *Lopke* does not address the previously noted shortcomings of *Teodosiu*, *Araujo*, and *Dutta*. As such, claims 11, 23, 35, and 42 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claims 1, 7, 8, 13, 19, 20, 25, 31, and 44-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of U.S. Patent Application Publication No. 2002/0066026 A1 to *Yau et al.* (hereinafter “*Yau*”). The Applicants respectfully traverse the rejection. In particular, claim 1 recites a method for optimizing private network file transfers comprising,

among other features, “determining by the server that the first and second nodes are part of the same private network,” where the first and second nodes are part of a peer-to-peer network. Claims 13 and 25 include similar features. The Applicants submit that none of the references, either alone or in combination, disclose determining by a server that first and second nodes are part of a same private network, where the first and second nodes are part of a peer-to-peer network. As correctly pointed out by the Patent Office, *Dutta* does not disclose this feature. (See Final Office Action, page 13). Nonetheless, the Patent Office maintains the rejection by indicating that *Yau* discloses this feature in paragraphs [0018], [0019], [0042], [0067], and [0070]-[0074]. (See Final Office Action, page 14). The Applicants respectfully disagree. While *Yau* does disclose checking for source clients, which are behind the same firewall as a requesting client, neither of these clients are part of a peer-to-peer network.

The Patent Office responds to this line of reasoning by indicating that *Yau* discloses the process of determining whether a requesting client and a source client are located within the same private network. (See Final Office Action, page 4). As mentioned above, *Yau* still does not disclose that the requesting client and the source client are part of a peer-to-peer network. The Patent Office addresses this argument by stating that the Applicants are attempting to argue the references individually and not in combination. (See Final Office Action, page 4). The Applicants respectfully disagree. Specifically, as acknowledged by the Patent Office, *Dutta* does not disclose that a server determines if first and second nodes are part of the same private network. (See Office Action mailed November 1, 2007, page 13; and Final Office Action, page 13). By acknowledging that *Dutta* does not disclose that a server determines if first and second nodes are part of the same private network, the Patent Office also acknowledges that *Dutta* does not disclose that a server determines if first and second nodes, which are part of a peer-to-peer network, are also part of the same private network. Due to this problem with *Dutta*, the Patent Office cites to *Yau*. The Applicants are merely rebutting the rejection issued by the Patent Office. The Applicants are explaining why, just like *Dutta*, *Yau* does not disclose determining by a server that first and second nodes, which are part of a peer-to-peer network, are also part of a same private network. Thus, the Applicants are arguing why, in combination, neither *Dutta* nor *Yau* discloses all of the features recited in claims 1, 7, 8, 13, 19, 20, 25, 31, and 44-46. Accordingly, claims 1, 13, and 25 are patentable over the cited references and the Applicants request that the rejection be withdrawn. In addition, claims 7, 8, 19, 20, 31, and 44-46, which

variously depend from claims 1, 13, and 25, are patentable for at least the same reasons along with the novel features recited therein.

Claims 2, 6, 14, 26, 30, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau* and further in view of U.S. Patent No. 6,304,912 B1 to *Oguchi et al.* (hereinafter “*Oguchi*”). The Applicants respectfully traverse the rejection. As discussed above, claims 1, 13, and 25, the base claims from which claims 2, 6, 14, 26, 30, and 32 variously depend, are patentable over *Dutta* and *Yau*. Furthermore, *Oguchi* does not address the previously noted shortcomings of *Dutta* and *Yau*. As such, claims 2, 6, 14, 26, 30, and 32 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claims 3-5, 9, 10, 12, 15-18, 21, 22, 24, 27-29, and 33-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau* and *Oguchi* and further in view of *Araujo*. The Applicants respectfully traverse the rejection. As detailed above, claims 1, 13, and 25, the base claims from which claims 3-5, 9, 10, 12, 15-18, 21, 22, 24, 27-29, and 33-36 respectively depend, are patentable over *Dutta*, *Yau*, and *Oguchi*. Moreover, *Araujo* does not overcome the previously noted problems of *Dutta*, *Yau*, and *Oguchi*. Thus, claims 3-5, 9, 10, 12, 15-18, 21, 22, 24, 27-29, and 33-36 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claims 11, 23, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau*, *Oguchi*, and *Araujo* and further in view of *Lopke*. The Applicants respectfully traverse the rejection. As shown above, claims 1, 13, and 25, the base claims from which claims 11, 23, and 35 respectively depend, are patentable over *Dutta*, *Yau*, *Oguchi*, and *Araujo*. Moreover, *Lopke* does not address the previously noted shortcomings of *Dutta*, *Yau*, *Oguchi*, and *Araujo*. As such, claims 11, 23, and 35 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claims 37 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau* and further in view of *Araujo*. The Applicants respectfully traverse the rejection. Claim 37 recites a method for optimizing private network file transfers comprising, among other features, “determining that the second node is part of the same private network as the first node,” where the first node and the second node are part of a peer-to-peer network. As previously discussed, neither *Dutta*, *Yau*, nor *Araujo*, either alone or in combination, discloses determining that a second node is part of a same private network as a first node where the first

and second nodes are part of a peer-to-peer network. Thus, claim 37, along with claim 47, which depends therefrom, is patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claims 38-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau* and *Araujo* and further in view of *Oguchi*. The Applicants respectfully traverse the rejection. As shown above, claim 37, the base claim from which claims 38-41 ultimately depend, is patentable over *Dutta*, *Yau*, and *Araujo*. Additionally, *Oguchi* does not address the previously noted shortcomings of *Dutta*, *Yau*, and *Araujo*. Thus, claims 38-41 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claims 42 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau*, *Araujo*, and *Oguchi* and further in view of *Lopke*. The Applicants respectfully traverse the rejection. As indicated above, claim 37, the base claim from which claims 42 and 43 ultimately depend, is patentable over *Dutta*, *Yau*, *Araujo*, and *Oguchi*. In addition, *Lopke* does not overcome the previously noted problems of *Dutta*, *Yau*, *Araujo*, and *Oguchi*. Therefore, claims 42 and 43 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

The present application is now in a condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact the Applicants' representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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